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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,500	09/30/2003	Kazuhiro Kuwabara	117369	2323

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EXAMINER	
OVANDO, PABLO R	
ART UNIT	**PAPER NUMBER**
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/673,500	KUWABARA ET AL.	
	Examiner	Art Unit	
	Pablo R. Ovando	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: at least there is a typographical error in paragraph 32 line 3.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/634828. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards an IP phone

device with capabilities of transmitting signals to connect with either a phone or internet network.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 1 defines a storage medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or computer-readable memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on "computer-readable

medium" or equivalent; assuming the specification does NOT define the computer readable medium as a "signal", "carrier wave", or "transmission medium" which are deemed non-statutory (refer to "note" below). Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1-11** are rejected under 35 U.S.C. 102(e) as being anticipated by Shnitzer et al, US Patent 7,061,901 (hereinafter referenced as Shnitzer).

As to **claim 1**, Shnitzer teaches an IP phone device comprising:

an NCU connected to a phone network (Fig. 5, DAA 130);

a handset that is used for making phone calls with a remote phone device through the NCU and the phone network while exchanging audio signals (col. 5, lines 59-61, note that fig. 1, element 100 displays a handset. Additionally, Col. 3, lines 40-48 teach that signaling is received by the PSTN/Switch 105 to establish a connection);

an audio interface (fig. 1, element 160) responsive to an Internet telephony execution

instruction, for inputting and outputting the audio signals for the phone calls to and from a remote IP phone device through Internet via the computer (col. 8, lines 43-60) ;

call-start instruction input means for inputting a call-start instruction for Internet telephony in accordance with user's actions (col. 14, lines 19-29);

path switching means (fig. 1, element 150) for switching a path from the NCU to the audio interface to output an audio signal input through the handset and to input an audio signal output from the handset through the audio interface when the call-start instruction for Internet telephony is input from the call-start instruction input means (col. 3, lines 40-47 and col. 7, lines 25-28): and

computer control means (fig. 1, element 180) for outputting control commands to a computer for executing Internet telephony to the computer from the audio interface when the call-start instruction for Internet telephony is input from the call-start instruction input means, the control commands being output in the form of an audio signal, the computer executing transmission/reception of the audio signals to and from the remote IP phone device (col. 14 lines 19-40, note that element 160 sends DTMF signals to element 180 which sends the signals to the computer, wherein the computer has element 190. Additionally, element 190 is able to acknowledge if the signal received is going to generate a call, and communicate the results back to the phone).

As to **claim 2**, Shnitzer teaches that the computer control means outputs the control commands in the form of a DTMF signal to the computer (col. 14, lines 25-27).

As to **claim 3**, Shnitzer teaches a phone device connection means for connecting a sub-phone device for allowing the sub-phone device to make phone calls with the

remote IP phone device, the computer control means receiving the control commands from the sub-phone device through the phone device connection means and transmitting the control commands to the computer in the form of a DTMF signal (col. 8, lines 32-37 teach that a cellular implementation of device 100 could be implemented, wherein the cellular implementation would be a wireless sub- terminal. Additional, col. 6, lines 11-16 teach that different phones can be connected to the same terminal).

As to **claim 4**, Shnitzer teaches computer connection means for connecting to the computer connected to Internet to allow the audio signals and other signals to input from and output to the computer through the computer connection means (fig. 5, element 200 displays an interface connecting to a PC which is taught in col. 8 lines 4-8).

As to **claim 5**, Shnitzer teaches that the computer is connected through an audio cable (col. 7, lines 34-37).

As to **claim 6**, Shnitzer teaches an IP phone system comprising:
a computer connectable to Internet (fig. 1, element 16, also fig. 5, elements 195 and 190 are part pf the PC);
and an IP phone comprising: an NCU connected to a phone network (Fig. 5, DAA 130); a handset that is used for making phone calls with a remote phone device through the NCU and the phone network while exchanging audio signals (col. 5, lines 59-61, note that fig. 1, element 100 displays a handset. Additionally, Col. 3, lines 40-48 teach that signaling is received by the PSTN/Switch 105 to establish a connection);

an audio interface (fig. 1, element 160) responsive to an Internet telephony execution instruction, for inputting and outputting the audio signals for the phone calls to and from a remote IP phone device through Internet via the computer (col. 14, lines 19-29);
call-start instruction input means for inputting a call-start instruction for Internet telephony in accordance with user's actions (col. 14, lines 19-29);
path switching means (fig. 1, element 150) for switching a path from the NCU to the audio interface to output an audio signal input through the handset and to input an audio signal output from the handset through the audio interface when the call-start instruction for Internet telephony is input from the call-start instruction input means (col. 3, lines 40-47 and col. 7, lines 25-28);
and computer control means (fig. 1, element 180) for outputting control commands to the computer for executing Internet telephony to the computer from the audio interface when the call-start instruction for Internet telephony is input from the call-start instruction input means, the control commands being output in the form of an audio signal, the computer executing transmission/reception of the audio signals to and from the remote IP phone device (col. 14, lines 19-40, note that element 160 sends DTMF signals to element 180 which sends the signals to the computer, wherein the computer has element 190. Additionally, element 190 is able to acknowledge if the signal received is going to generate a call, and communicate the results back to the phone).

As to **claim 7**, Shnitzer teaches the computer control means outputs the control commands in the form of a DTMF signal to the computer (col. 14, lines 25-27).

As to **claim 8**, Shnitzer teaches phone device connection means for connecting a sub-phone device for allowing the sub-phone device to make phone calls with the remote IP phone device, the computer control means receiving the control commands from the sub-phone device through the phone device connection means and transmitting the control commands to the computer in the form of a DTMF signal (col. 8, lines 32-37 teach that a cellular implementation of device 100 could be implemented, wherein the cellular implementation would be a wireless sub- terminal. Additional, col. 6, lines 11-16 teach that different phones can be connected to the same terminal).

As to **claim 9**, Shnitzer teaches computer connection means for connecting to the computer connected to Internet to allow the audio signals and other signals to input from and output to the computer through the computer connection means (fig. 5, element 200 displays an interface connecting to a PC which is taught in col. 8 lines 4-8).

As to **claim 10**, Shnitzer teaches the computer is connected through an audio cable (col. 7, lines 34-37).

As to **claim 11**, Shnitzer teaches a computer-readable medium (fig. 5, element 190) storing an Internet telephony program for installing Into a computer, comprising a program for Implementing communication processing entailed by an Internet telephony in accordance with control commands in the form of a DTMF signal received from an IP phone device connected to the computer (col. 14, lines 19-45, note that the computer connects element 100 with the pc 16 to initiate a call by exchanging DTMF signals. Additionally, col. 10 lines 15-18 teach the different programs used by the computer).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo R. Ovando whose telephone number is 571-272-9752. The examiner can normally be reached on M-F 7:30 am to 5:00pm, EST,Alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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